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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,273	07/24/2007	Tetsuzo Miki	296975US0X PCT	3412

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
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EXAMINER

CROUSE, BRETT ALAN

ART UNIT	PAPER NUMBER
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1786

NOTIFICATION DATE	DELIVERY MODE
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03/16/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/594,273

Applicant(s)

MIKI ET AL.

Examiner

BRETT A. CROUSE

Art Unit

1786

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 February 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-27.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/D. Lawrence Tarazano/
Supervisory Patent Examiner, Art Unit 1786

/B. A. C./
Examiner, Art Unit 1786

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant argues with respect to the rejection over Qiu and the rejection over Sato that the references do not provide a prima facie case of obviousness because the references do not provide an exemplified example compound with the instant claims. Applicant additionally argues that the subgenus claimed in the instant invention should not be rejected solely by the generic disclosure of the applied references which encompasses the compounds of the instant claims.

With regard to Qiu opposite the instant claims. The scope of the instant claims requires the substituent to Ar to be selected from fluorine, chlorine, cyano, nitro, alkyl, alkoxy, trifluoromethyl, phenyl, tolyl, naphthyl and aralkyl. Qiu teaches for the substituents in column 6, lines 3-5, hydrogen, alkyl, alkoxy, aromatic, fluoroalkyl, halogen and cyanic groups. The degree of overlap between the substituent groups of Qiu and the groups of the instant claims is nearly identical. This is not a case of a genus rejecting a species as argued by applicant. This is a case in which while Qiu does not exemplify compounds, Qiu clearly teaches a high degree of overlap of groups and uses the compounds in the manner as contemplated by applicant. It is applicant that provides functional groups beyond the exemplified groups of Qiu. Applicant claims aralkyl groups and nitro groups which are not recited by Qiu. Thus, in contrast to applicant's argument the scope of Qiu is not significantly broader than the instant claims resulting in a need to pick and choose.

It is further noted that applicant only presents one compound, compound (3) of page 9 of the instant specification and current instant claims 16 and 27 within the scope of the instant claims. Applicant relies on the same level of generic disclosure having closely matching scope to that of the prior art.

Similarly, Sato recites a list of substituents having a high degree of overlap with the recited groups of the instant claims and uses the resulting compounds in the manner as contemplated by applicant.

Applicant argues with respect to the rejection over Lee that the reference does not provide a prima facie case of obviousness because the reference does not provide an exemplified example compound with the instant claims. Applicant additionally argues that the subgenus claimed in the instant invention should not be rejected solely by the generic disclosure of the applied reference which encompasses the compounds of the instant claims. Applicant points to paragraph [0033] and formula (7) of Lee as teaching away from the claimed invention of the instant application.

The description of paragraph [0033] is a preferred embodiment of Lee in which R11 and R12 combine to form further fused rings. The teachings of Lee encompass a broader scope of compounds than that which is recited in paragraph [0033]. Attention is directed to paragraph [0011] which teaches each of R11 and R12 can be groups including alkyl, alkoxy, aryl, cyano, nitro and halogen. Paragraph [0011] teaches that R11 and R12 can optionally combine to form further substituted or unsubstituted rings. Attention is also directed to paragraph [0026] which teaches the substituents to the further rings formed by the combination of R11 and R12. The substituents to rings include various aryl and heteroaryl groups. Phenyl and naphthyl groups are exemplified as substituents.

Applicant additionally argues unexpected results opposite the properties of instant compounds (2) and (3) as recited in the instant specification. Instant compound (2) is also an exemplified compound of Qiu and Sato.

Compound (2) and (3) CDPF and CDMPF possess similar properties. The ionization potential differs between the compounds by 0.04 eV and accounting for the band gap the electron affinity differs by only 0.01 eV. The prior art teaches CDPF explicitly and suggests alkyl substituents to the compound skeleton. Sato in paragraph [0048] and Qiu in the exemplified compounds beginning in column 6 provide methyl substituents to the phenyl linking groups of the carbazole derivatives. Both the exemplified CDPF compound of the prior art and CDMPF compound of the instant specification have been shown to be suitable for use in the electroluminescent arts. The properties of the materials as they relate to device performance are related to the environment in which they are used in conjunction with the other materials of an electroluminescent device. As such there is no showing as to the combination of materials used in conjunction with CDMPF that would provide unexpected device performance.